

36. (New) The device according to claim 35, wherein the insulation includes an insulating sleeve composed of a plastic.

37. (New) The device according to claim 35, wherein in an assembled state, a back wall of the plug acts as a further insulation which, together with the insulation between the terminal contacts, form two contact chambers insulated from one another.

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38. (New) The device according to claim 18, wherein the at least one sleeve contact has a diameter so as to overcome a predetermined contacting force when connected.

39. (New) The device according to claim 18, further comprising:  
a plurality of punched grid conductors connected to the plug.--

#### REMARKS

##### I. Introduction

With the addition of claims 20 to 39, claims 1 and 3 to 39 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that claims 1 and 3 to 39 are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority and that all certified copies of priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

##### II. Rejection of Claims 1, 3, 5, 7, 9 to 16 and 19 Under 35 U.S.C. § 102(e)

Claims 1, 3, 5, 7, 9 to 16 and 19 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,759,069 ("Kitatani et al."). Applicants respectfully submit that Kitatani et al. do not anticipate the present claims for the following reasons.

As an initial matter, the quoted section of 35 U.S.C. reproduced in the Office Action is inapplicable to the present application, and the statements that "[t]he changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of

1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b)" and that "the application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA" plainly demonstrate that the present rejection is not based on a statute applicable to the present application. In this regard, 35 U.S.C. § 102(e) was amended pursuant to the "Intellectual Property and High Technology Technical Amendments Act of 2002," Pub. L. 107-273, 16 Stat. 1901 (2002), and the amendments to 35 U.S.C. § 102(e) made thereby "apply to all patents and applications for patents pending on or filed after November 29, 2000." Pub. L. 107-273 at § 4508. Accordingly, because the present rejection is based on a statute that was made inapplicable to the present application, withdrawal of this rejection is respectfully requested.

Notwithstanding the foregoing and to facilitate prosecution of the present application, Applicants address below, without waiver or prejudice, the anticipation rejection even though the anticipation rejection is believed to be improper for the reasons more fully set forth above.

Claim 1 relates to a device for contacting an electrically operated apparatus. Claim 1 recites at least one terminal contact on a side of the apparatus, the at least one terminal contact being oriented parallel to an installation direction of the apparatus. Claim 1 also recites a plug for connecting axially to the at least one terminal contact, the plug including at least one sleeve contact, the at least one sleeve contact and the at least one terminal contact being adapted to be assembled together parallel to the installation direction, wherein the at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contacts connecting to the two concentric terminal contacts.

The Office Action alleges that Kitatani et al. disclose a device for contacting an electrically operated apparatus (J), comprising at least one terminal contact (6,8) on a side of the apparatus (J), the at least one terminal contact (6,8) being oriented parallel to an installation direction of the apparatus (J). The Office Action further alleges that Kitatani et al. disclose a plug (P) including at least one sleeve contact (2,3), the at least one sleeve contact (2,3) and the at least one terminal contact (6,8) being adapted to be assembled together parallel to the installation direction and the at least one terminal contact (6,8) includes two

concentric terminal contacts (6,8) at least one sleeve contact (2,3) including two concentric sleeve contacts (2,3).

Kitatani et al. do not disclose, or even suggest, the at least one terminal contact includes two concentric sleeve contacts, the two concentric sleeve contacts connecting to the two terminal contacts. Elements 6 and 8 are not concentric as illustrated in Figure 6. As elements 6 and 8 are not concentric, Applicants respectfully request withdrawal of this rejection.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Kitatani et al. do not disclose, or even suggest all of the limitations of claim 1, including at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contact connecting to the concentric terminal contacts. It is therefore respectfully submitted that Kitatani et al. do not anticipate claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the references relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied

art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Kitatani et al. do not anticipate claim 1.

As for claims 3, 5, 7, 9 to 16 and 19, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that Kitatani et al. do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

### III. Rejection of Claim 6 Under 35 U.S.C. § 103(a)

Claim 6 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kitatani et al. in view of U.S. Patent No. 5,971,810 ("Taylor"). Applicants respectfully submit that the combination of Kitatani et al. and Taylor does not render obvious claim 6 for the following reasons.

Claim 6 depends from claim 1, and therefore include all of the limitations of claim 1. As indicated above, Kitatani et al. do not disclose, or even suggest, all of the limitations of claim 1, from which claim 6 depends. Taylor is not relied on for disclosing or suggesting the limitations of claim 1 not disclosed or suggested by Kitatani et al. Indeed, Taylor do not disclose, or even suggest, the limitations of claim 1 not disclosed or suggest by Kitatani et al. In this regard, the Office Action relies on Taylor for purporting to disclose use of plastic as an insulation. The Office Action does not even contend that Taylor discloses, or even suggests, that at least one sleeve contact includes two concentric sleeve contacts and that at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contact connecting to the concentric terminal contacts as recited in claim 1, from which claim 6 depends.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some

suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of Kitatani et al. and Taylor does not disclose, or even suggest, all of the limitations of claim 1, from which claim 6 depends. It is therefore respectfully submitted that the combination of Kitatani et al. and Taylor does not render obvious claim 6, which depends from claim 1.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so,

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 6. It is therefore respectfully submitted that claim 6 is allowable for these reasons.

**IV. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter contained in claims 4, 8, 17 and 18. In this regard, the Examiner will note that each of claims 4, 8, 17 and 18 has been rewritten herein in independent form to include all of the limitations of its respective base claim and any intervening claims. It is therefore respectfully submitted that claims 4, 8, 17 and 18 are in condition for immediate allowance.

**V. New Claims 20 to 39**

New claims 20 to 39 have been added herein. It is respectfully submitted that new claims 20 to 39 do not add any new matter and are fully supported by the present application. It is respectfully submitted that these claims are allowable.

**VI. Conclusion**

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached pages are captioned "Version with Markings to Show Changes Made."

It is therefore respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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**Version with Markings to Show Changes Made**

**IN THE CLAIMS:**

Claims 4, 8, 17 and 18 have been amended, without prejudice, as follows:

4. (Twice Amended) [The device according to claim 1,] A device for contacting an electrically operated apparatus, comprising:  
at least one terminal contact on a side of the apparatus, the at least one terminal contact being oriented parallel to an installation direction of the apparatus;  
and

a plug for connecting axially to the at least one terminal contact, the plug including at least one sleeve contact, the at least one sleeve contact and the at least one terminal contact being adapted to be assembled together parallel to the installation direction, wherein the at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contacts connecting to the two concentric terminal contacts, wherein the terminal contacts have two contact plates bent into a cylindrical shape and situated on an end of a casing of the apparatus.

8. (Amended) [The device according to claim 1,] A device for contacting an electrically operated apparatus, comprising:

at least one terminal contact on a side of the apparatus, the at least one terminal contact being oriented parallel to an installation direction of the apparatus;  
and

a plug for connecting axially to the at least one terminal contact, the plug including at least one sleeve contact, the at least one sleeve contact and the at least one terminal contact being adapted to be assembled together parallel to the installation direction, wherein the at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contacts connecting to the two concentric terminal contacts, wherein the at least one sleeve contact includes an

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interior sleeve contact and an exterior sleeve contact, a printed conductor of the interior sleeve contact passing through a recess in the exterior sleeve contact.

17. (Amended) [The device according to claim 1,] A device for contacting an electrically operated apparatus, comprising:

at least one terminal contact on a side of the apparatus, the at least one terminal contact being oriented parallel to an installation direction of the apparatus; and

a plug for connecting axially to the at least one terminal contact, the plug including at least one sleeve contact, the at least one sleeve contact and the at least one terminal contact being adapted to be assembled together parallel to the installation direction, wherein the at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contacts connecting to the two concentric terminal contacts, wherein the electrically operated apparatus includes an actuator.

18. (Amended) [The device according to claim 1,] A device for contacting an electrically operated apparatus, comprising:

at least one terminal contact on a side of the apparatus, the at least one terminal contact being oriented parallel to an installation direction of the apparatus; and

a plug for connecting axially to the at least one terminal contact, the plug including at least one sleeve contact, the at least one sleeve contact and the at least one terminal contact being adapted to be assembled together parallel to the installation direction, wherein the at least one sleeve contact includes two concentric sleeve contacts and the at least one terminal contact includes two concentric terminal contacts, the two concentric sleeve contacts connecting to the two concentric terminal contacts, wherein the electrically operated apparatus includes at

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least one of an actuator, a hydraulic actuator, a solenoid valve and a pressure regulator.

Claims 20 to 39 have been added.